

Appl. No. : 10/035,347
Filed : December 28, 2001

REMARKS

Claims 1-29 remain pending in the present application. In the November 5, 2004 Office Action, the Examiner objected to Claims 7 and 25 for informalities. The Examiner rejected Claims 25-29 under 35 USC § 112, second paragraph. Claims 1, 3-6, 11 and 13-24 stand rejected under 35 USC § 101. The Examiner rejected Claims 7-9, 11-12, 14-20, 24-25 and 27-28 under 35 USC § 102(e) as being anticipated by U.S. Patent No. 6,189,146 to Misra et al ("Misra"). Claim 26 stands rejected under 35 USC § 103(a) as being unpatentable over Misra. Claims 1-6, 13, 21-23 and 29 stand rejected under 35 USC § 103(a) as being unpatentable over Misra in view of U.S. Patent No. 5,940,504 to Griswold. Claim 10 stands rejected under 35 USC § 103(a) as being unpatentable over Misra in view of U.S. Patent No. 5,838,910 to Domenikos.

Discussion of Objections

Claims 7 and 25 have been amended to overcome the Examiner's objections made in paragraph 2 of the Office Action. Applicant therefore respectfully requests the Examiner to withdraw the objections to Claims 7 and 25.

Discussion of Rejection under 35 U.S.C. § 112

Claim 25 has been amended to provide the clarification requested by the Examiner in paragraph 4 of the Office Action. Thus, the Applicant requests withdrawal of the rejection of independent Claim 25, and dependent Claims 26-29, under 35 U.S.C. § 112.

Discussion of Rejection under 35 U.S.C. § 101

The Examiner rejected Claim 1, 3-6, 11 and 13-24 under 35 U.S.C. § 101. In response, independent Claims 1 and 3-6 have been amended to recite "stored in computer readable memory" as advised by the Examiner. Independent Claim 11 has been amended to recite "electronically receiving" as advised by the Examiner, and so is within the technological arts. Claims 13-24 depend from and further define Claim 11, and so are likewise in the technological arts. Applicant therefore respectfully requests withdrawal of the rejection of Claims 1, 3-6, 11 and 13-24 under 35 U.S.C. § 101.

Discussion of rejections under 35 USC § 102(a)

To anticipate a claim, the reference must teach every element of the claim. See MPEP § 2131 at 2100-70. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." See

Appl. No. : 10/035,347
Filed : December 28, 2001

id. (quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987)) (emphasis added).

Because Misra does not disclose, expressly or inherently, each claim element of Claims 7-9, 11-12, 14-20, 24-25 and 27-28, as amended, Applicant respectfully submits that Claims 7-9, 11-12, 14-20, 24-25 and 27-28 are allowable over Misra.

For example, with respect to amended Claim 7, Misra does not disclose or suggest a module configured to visually present to a first potential licensee a first license form including license terms defined by a first intellectual property rights licensor, and present to a second potential licensee a second license form including license terms defined by a second intellectual property rights licensor.

Instead, Misra at column 15, line 56- column 16, line 6, as cited by the Examiner, merely discloses:

"FIG. 7 shows a more detailed method for providing a platform challenge to the client. In this illustration, the intermediate server 32 is shown as the go between, with the forwarding steps omitted for ease of description. An aspect of platform validation is establishing the authenticity of the client. The system utilizes the client's executable image to generate a digital signature that uniquely identifies the client. As noted above, the client's executable image is available to the license server 28 because it is stored in the client image cache 120. When a client requests a software license from the license server, the client 30 submits a client software ID (step 220 in FIG. 7). The software ID is assigned by the software manufacturer/vendor to be unique for each client release. The client software ID is a bit field that contains a platform identifier, a vendor identifier, and a client revision field. The arrangement of the bits depends on how many platforms and clients are supported."

Thus, rather than teach or suggest the invention as claimed by amended Claim 7, Misra discloses an automated platform challenge to a client computer system. Thus, even assuming, arguendo, that the secure license store 122 is a licensor as asserted by the Examiner, because Misra does not expressly or inherently describe elements in Claim 7, Applicant respectfully submits that Claim 7 is allowable and requests that the Examiner withdraw the rejection and allow Claim 7.

With respect to amended Claim 11, by way of example, Misra does not disclose or suggest "electronically receiving from a rights licensor of a first media an instruction defining which system entities and entity attributes can be used as search parameters by a search engine," as claimed. While the Examiner asserts that the foregoing element is disclosed by Misra at

column 10, line 45 – column 11, line 30, and Figure 3, a careful review of the foregoing citation fails to disclose “electronically receiving from a rights licensor of a first media an instruction defining which system entities and entity attributes can be used as search parameters by a search engine.” Instead, Misra at column 10, line 45 – column 11, line 30, merely discloses:

The client authenticating module 124 compares the client executable image received from the client to the client executable image stored in the client image cache 120. The client is deemed authentic if the two images match. The client authenticating module 124 informs the granting module 126 when the client is authenticated.

The granting module 126 grants a software license from the secure license store 112 to the authenticated client. To prevent an issued license from being copied from machine to machine, the software license is assigned to a specific client by assigning a client ID to the license and including that ID within the license. The software license is also given a license ID. The license ID is associated with the client ID in the client assignment table 116 to track which client receives the issued license.

The license server 28, based on information derived from the license pack, fills in fields of a license data structure at the time the license is issued. As one example, the license data structure is implemented using an X.509 certificate, which is well known in the art. The license server 28 then digitally signs the software license using a signing key that is not disclosed to the client. Table 5 shows the data fields of a software license data structure.

....

As part of the granting process, the client assignment table 116 is updated to reflect that a particular license having a specific license ID is issued to a particular client having a specific client ID. Additionally, the number assigned field in the license pack table 114 is updated to reflect that another license has been assigned to a client.

Figure 3 of Misra further fails to disclose “electronically receiving from a rights licensor of a first media an instruction defining which system entities and entity attributes can be used as search parameters by a search engine.”

Further, Misra does not disclose or suggest electronically receiving from a rights licensor instructions as to what human perceptible notifications are to be provided to the rights licensor and to the potential licensee during the licensing transaction, or electronically receiving from the rights licensor authorizing instructions configured to specify which person is authorized to perform predetermined acts during the licensing transaction, as recited by amended Claim 11.

Because Misra does not expressly or inherently describe elements in Claim 11, Applicant respectfully submits that Claim 11 is allowable and requests that the Examiner withdraw the rejection and allow Claim 11.

Appl. No. : 10/035,347
Filed : December 28, 2001

With respect to Claim 25, the Examiner has inadvertently mischaracterized Misra. The Examiner takes the position that Misra, at column 11, Table 5, column 15, line 47 – column 16, line 37, and Figures 3, 6-7, discloses receiving a user response to the licensing terms, the user response including one of a license acceptance, a counteroffer, and an indication that the user is not proceeding with the licensing transaction.

However, Misra, at Table 5, merely discloses a software license data structure, and does not disclose a user response including one of a license acceptance, a counteroffer, or an indication that the user is not proceeding with the licensing transaction. Further, Misra, at column 15, line 47 column 16, line 37, describes how the license server 28 processes an “improper” response from a client, and further describes validating the authenticity of the client. Thus, the license server 28 of Misra determines whether or not to proceed with the licensing process in the event that the client is not authenticated. Misra, at column 15, line 47 column 16, line 37, does not disclose a user response including one of a license acceptance, a counteroffer, or an indication that the user is not proceeding with the licensing transaction. Figures 3, 6-7, similarly disclose the treatment of an authentication failure, or a challenge failure, and do not teach or suggest a user response including one of a license acceptance, a counteroffer, or an indication that the user is not proceeding with the licensing transaction.

Further, Misra fails to disclose instructions stored in computer readable memory configured to transmit over a network to a first user first licensing terms defined by a licensor for a first media property and to transmit over a network to a second user second licensing terms defined by a licensor for a second media property, as claimed by amended Claim 25.

Because Misra does not expressly or inherently describe elements in Claim 25, Applicant respectfully submits that Claim 25 is allowable and requests that the Examiner withdraw the rejection and allow Claim 25.

Discussion of rejections under 35 USC § 103(a)

The Examiner rejected Claim 1 under 35 USC § 103(a) as being unpatentable over Misra in view of Griswold. However, in order to establish prima facie obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. See MPEP § 2143.03. In this case, the combination of Misra and Griswold fail to satisfy this basic requirement.

For example, with respect to amended Claim 1, Misra does not disclose or suggest a rights exchange application configured to “receive a licensing request manually provided by a potential human licensee related to a first media property.” Further, Misra does not disclose or suggest a rights exchange application configured to: “cause a first license template defined by the rights owner to be visually presented to the potential human licensee”; “receive first license template entries manually provided by the potential licensee”; or “transmit in real-time the first license template entries to be visually presented to the rights owner.”

Instead, Misra at column 15, line 56- column 16, line 6, as cited by the Examiner, merely discloses:

“FIG. 7 shows a more detailed method for providing a platform challenge to the client. In this illustration, the intermediate server 32 is shown as the go between, with the forwarding steps omitted for ease of description. An aspect of platform validation is establishing the authenticity of the client. The system utilizes the client's executable image to generate a digital signature that uniquely identifies the client. As noted above, the client's executable image is available to the license server 28 because it is stored in the client image cache 120. When a client requests a software license from the license server, the client 30 submits a client software ID (step 220 in FIG. 7). The software ID is assigned by the software manufacturer/vendor to be unique for each client release. The client software ID is a bit field that contains a platform identifier, a vendor identifier, and a client revision field. The arrangement of the bits depends on how many platforms and clients are supported.”

Thus, rather than teach or suggest the invention as claimed by Claim 1, Misra discloses an automated platform challenge to a client computer system.

Further, the Examiner admits that Misra fails to teach that a rights owner application receives pricing and payment rules. Nonetheless, the Examiner relies on Griswold to supply the missing element.

However, Misra does not even mention pricing or payment rules. Therefore, even if Misra were to receive and store pricing or payment rules, Misra does not disclose using pricing or payment rules. Thus, there would be no motivation to modify Misra with the disclosure of Griswold as proposed by the Examiner, much less the invention as claimed. Because, whether analyzed alone or in combination, Misra and Griswold do not teach or suggest all the claimed elements, and because there would be no motivation to modify Misra with the disclosure of

Appl. No. : 10/035,347
Filed : December 28, 2001

Griswold as proposed by the Examiner, Applicant respectfully requests the Examiner to withdraw the rejection to Claim 1 under 35 U.S.C. § 103(a).

Conclusion

In view of the foregoing remarks and amendments, Applicant respectfully maintains that independent Claims 1, 7, 11 and 25 are patentably distinct over the cited art, and are in condition for allowance. Claims 2-6, Claims 8-10, Claims 12-24, and Claims 26-29 which respectively depend from independent Claims 1, 7, 11 and 25 and further define Claims 1, 7, 11 and 25 are likewise patentably distinct over the cited art and are in condition for allowance. Applicant therefore respectfully requests withdrawal of the rejection of Claims 1-29, and requests that the Examiner allow Claims 1-29.

Request for Telephone Interview

If there are any issues that can be resolved by telephone, the Examiner is respectfully requested to call the undersigned attorney of record at (310) 407-3461 or at the number set forth below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: May 5, 2005

By: 

David N. Weiss
Registration No. 41,371
Attorney of Record
Customer No. 20,995
(310) 551-3450